



SPS AVAILABLE COPY

ATTORNEY DOCKET NO. 14014.0347U3  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
BERZOFSKY <i>et al.</i>	)	
	)	Group Art Unit: 1642
Application No.: 10/770,117	)	
	)	Examiner: Unassigned
Filed: February 2, 2004	)	
	)	Confirmation No. 9347
FOR: MODIFIED HCV PEPTIDE VACCINES	)	

PETITION FOR CORRECTION OF INVENTORSHIP IN PATENT APPLICATION,  
PURSUANT TO 37 C.F.R. § 1.48(a)

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.  
Customer No. 36339

Sir:

This application is a continuation application of U.S. Application No. 09/763,260, now U.S. Patent No. 6,685,944, issued February 3, 2004, in which a Petition for Correction of Inventorship in Patent Application, pursuant to 37 C.F.R. § 1.48(a) was granted May 17, 2002. Because the inventorship of the pending application is the same as the inventorship in U.S. Patent No. 6,685,944, applicants respectfully request that the inventorship be corrected accordingly.

Therefore, pursuant to 37 C.F.R. § 1.48(a), applicants hereby petition for correction of inventorship of the above-captioned patent application to delete Charles D. Pendleton and

ATTORNEY DOCKET NO. 14014.0347U3  
APPLICATION NO. 10/770,117

Tatsumi Arichi as co-inventors. The inventorship originally set forth in the application was in error in naming Mr. Pendleton and Dr. Arichi, without deceptive intent on the part of the named inventors, nor on the part of any other party or parties.

The inventors of the present invention are Jay A. Berzofsky, Pablo Sarobe, Stephen M. Feinstone and Marian E. Major.

This petition is accompanied by a copy of the documents filed with the United States Patent and Trademark Office (PTO) in Application No. 09/763,260 and a copy of the documents mailed by the PTO to applicants in Application No. 09/763,260. These documents include the following:

- (1) a Petition for Correction of Inventorship in Patent Application Pursuant to 37 C.F.R. § 1.48(a), dated October 19, 2001, accompanied by:
  - (a) a statement from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his part;
  - (b) a Declaration executed by the actual inventors pursuant to 37 C.F.R. § 1.63;
  - (c) the written consent of the assignee, The Government of the United States of America, as Represented by the Secretary, Department of Health and Human Services, National Institutes of Health, Office of Technology Transfer, as required under 37 C.F.R. § 1.48(a);
- (2) a Decision on Request Under 37 C.F.R. § 1.497(d), dated February 20, 2002;
- (3) a Renewed Petition for Correction of Inventorship in Patent Application Pursuant to 37 C.F.R. § 1.497(d), dated April 17, 2002, accompanied by:

ATTORNEY DOCKET NO. 14014.0347U3  
APPLICATION NO. 10/770,117

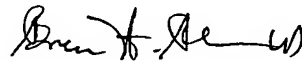
to 37 C.F.R. § 1.497(d), dated April 17, 2002, accompanied by:

- (a) the Consent of Assignee; and
- (4) a Decision on Request Under 37 C.F.R. § 1.497(d), dated May 17, 2002, granting the petition.

A Credit Card Payment Form PTO-2038 authorizing payment in the amount of \$130.00 (fee for Petition under 37 C.F.R. § 1.17(i)) is enclosed. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

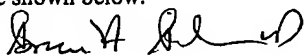


Bruce H. Becker, M.D., J.D.  
Registration No. 48,884

NEEDLE & ROSENBERG, P.C.  
999 Peachtree Street  
Suite 1000  
Atlanta, Georgia 30309-3915  
678-420-9300  
678-420-9301 (fax)

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.



Bruce H. Becker, M.D., J.D.

2/28/05

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
BERZOFSKY <i>et al.</i>	)	
	)	Group Art Unit: Unassigned
Serial No.: 09/763,260	)	
	)	Examiner: Unassigned
Filed: February 20, 2001	)	
	)	
FOR: MODIFIED HCV PEPTIDE VACCINE	)	

**PETITION FOR CORRECTION OF INVENTORSHIP IN PATENT APPLICATION,**  
**PURSUANT TO 37 C.F.R. § 1.48(a)**

Commissioner for Patents  
BOX PCT  
Washington, D.C. 20231

NEEDLE & ROSENBERG, P.C.  
Suite 1200, The Candler Building  
127 Peachtree Street, N.E.  
Atlanta, Georgia 30303-1811

October 19, 2001

Sir:

Pursuant to 37 C.F.R. §1.48(a), applicants hereby petition for correction of inventorship of the above-captioned patent application to delete Charles D. Pendleton and Tatsumi Arichi as co-inventors. The inventorship originally set forth in the application was in error in naming Mr. Pendleton and Dr. Arichi, without deceptive intent on the part of the named inventors, nor on the part of any other party or parties. The inventors of the present invention are Jay A. Berzofsky, Pablo Sarobe, Stephen M. Feinstone and Marian E. Major.

ATTORNEY DOCKET NO. 14014.0347U2  
PATENT

This petition is accompanied by:

- (1) a statement from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his part;
- (2) a Declaration executed by the actual inventors pursuant to 37 C.F.R. § 1.63;
- (3) the written consent of the assignee, The Government of the United States of America, as Represented by the Secretary, Department of Health and Human Services, National Institutes of Health, Office of Technology Transfer, as required under 37 C.F.R. §1.48(a);
- (4) Request for Extension of Time;
- (5) a check in the amount of \$1,180.00 (\$130.00 surcharge under 37 C.F.R. § 1.16(e), \$130.00 surcharge under 37 C.F.R. § 1.17(i) and \$920.00 extension of time fee;
- (6) a Sequence Listing on Diskette;
- (7) Response to Notification of Missing Requirements Under 35 U.S.C. § 371;
- (8) a copy of the Notification of Missing Requirements Under 35 U.S.C. § 371;
- (9) a copy of the Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures and;
- (10) a copy of the Notification of a Defective Oath or Declaration

ATTORNEY DOCKET NO. 14014.0347U2  
PATENT

A check in the amount of \$1,180.00 (\$130.00 surcharge under C.F.R. § 1.16(e), \$130.00 surcharge under 37 C.F.R. § and \$920.00 extension of time fee) is attached. This amount is believed to be correct; however, the the Commissioner is hereby authorized to charge any additional fees due or credit any overpayment to Deposit Account 14-0629. Should there be any questions, please contact the undersigned at 404/688-0770.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.



Mary L. Miller

Registration No. 39,303

NEEDLE & ROSENBERG, P.C.  
Suite 1200, The Candler Building  
127 Peachtree Street, N.E.  
Atlanta, Georgia 30303-1811  
404/688-0770

Express Mail No. EL 491587244US

Certificate of Express Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Invoice No. 491587244US in an envelope addressed to: Commissioner for Patents, BOX PCT, Washington, D.C. 20231, on the date shown below.

  
Eric Potter

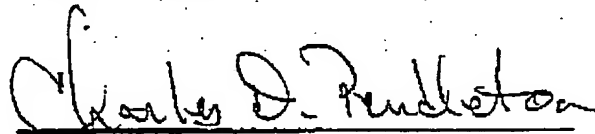
10-19-01  
Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
BERZOFSKY <i>et al.</i>	)	
	)	Group Art Unit: Unassigned
Serial No.: 09/763,260	)	
	)	Examiner: Unassigned
Filed: February 20, 2001	)	
	)	
FOR: "MODIFIED HCV PEPTIDE VACCINE"	)	

**STATEMENT OF CHARLES D. PENDLETON  
ACCOMPANYING PETITION FOR CORRECTION OF INVENTORSHIP  
IN PATENT APPLICATION, PURSUANT TO 37 C.F.R. § 1.48(a)**

I, Charles D. Pendleton, state that I am not a co-inventor of the invention, described and claimed in the above-captioned patent application, and that the error in my being named as an inventor occurred without deceptive intention on my part.



Charles D. Pendleton

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
BERZOFSKY <i>et al.</i>	)	
	)	Group Art Unit: Unassigned
Serial No.: 09/763,260	)	
	)	Examiner: Unassigned
Filed: February 20, 2001	)	
	)	
FOR: "MODIFIED HCV PEPTIDE VACCINE"	)	

**STATEMENT OF TATSUMI ARICHI  
ACCOMPANYING PETITION FOR CORRECTION OF INVENTORSHIP  
IN PATENT APPLICATION, PURSUANT TO 37 C.F.R. § 1.48(a)**

I, Tatsumi Arichi, state that I am not a co-inventor of the invention, described and claimed in the above-captioned patent application, and that the error in my being named as an inventor occurred without deceptive intention on my part.

Tatsumi Arichi

Tatsumi Arichi

10/10/2001



(X) Original                  ( ) Supplemental                  ( ) Substitute                  ( ) PCT

My residence, post office address and citizenship are as stated below next to my name.

(check one)    ☐ which is attached hereto, or  
                    ☐ which was filed on , as Application Serial No. and with amendments through  
                                        (if applicable), or  
                    ☒ in International Application No. PCT US99/18674, filed August 17, 1999, with  
                                        amendments as provided in the Preliminary Amendment filed on February 20, 2001.

I acknowledge the duty to disclose all information known by me to be material to the patentability of the claims of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code §119 (a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed:

PRIOR FOREIGN APPLICATIONS: (ENTER BELOW IF APPLICABLE)			PRIORITY CLAIMED (MARK APPROPRIATE BOX BELOW)	
APP. NUMBER	COUNTRY	DAY/MONTH/YEAR FILED	YES	NO
PCT/US99/18674	PCT	17 August 1999	X	

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

APPLICATION NUMBER	FILING DATE
60/097,446	21 August 1998

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information known by me to be material to the patentability of the claims of this application as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION SERIAL NO.	FILING DATE	STATUS (MARK APPROPRIATE COLUMN BELOW)		
		PATENTED	PENDING	ABANDONED

I hereby appoint the following attorneys to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected therewith:

James C. Haight, Reg. No. 25,588, Robert Benson, 33,612, Jack Spiegel, 34,477, Susan S. Rucker, 35,762, David R. Sadowski, 32,808, Steve Ferguson, 38,448; John Peter Kim, 38,514, Stephen L. Finley, 36,357, Norbert Pontzer, 40,777, Richard U. Rodriguez, 45,980, and Marlene Shinn, 46,005.

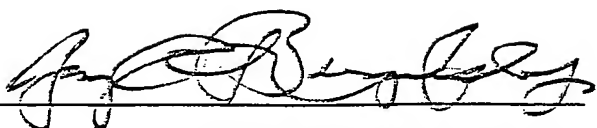
Address all telephone calls to Mary L. Miller at telephone no. (404) 688-0770.

Address all correspondence to:

Mary L. Miller, Ph.D.  
NEEDLE & ROSENBERG, P.C.  
Suite 1200, The Candler Building  
127 Peachtree Street, N.E.  
Atlanta, Georgia 30303-1811

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of first inventor: Jay A. Berzofsky

Inventor's signature: 

Date: 10/23/01

Residence: 5908 Bradley Boulevard, Bethesda, MD 20814-1107

Post Office Address: 5908 Bradley Boulevard, Bethesda, MD 20814-1107

Citizenship: United States

Full name of second inventor: Stephen M. Feinstone

Inventor's signature: \_\_\_\_\_

Date: \_\_\_\_\_

Residence: 3021 Cathedral Avenue, Washington, D.C. 20008

Post Office Address: 3021 Cathedral Avenue, Washington, D.C. 20008

Citizenship: United States

Full name of third inventor: Marian E. Major

Inventor's signature: \_\_\_\_\_

Date: \_\_\_\_\_

Residence: 6608 Potomac Avenue, Apt. B2, Alexandria VA 22307

Post Office Address: 6608 Potomac Avenue, Apt. B2, Alexandria, VA 22307

Citizenship: United Kingdom

Full name of fourth inventor: Pablo Sarobe

Inventor's signature: \_\_\_\_\_

Date: \_\_\_\_\_

Residence: C/San Fermin 59 2D, 31003 Pamplona, Spain

Post Office Address: C/San Fermin 59 2D, 31003 Pamplona, Spain

Citizenship: Spain

(X) Original            ( ) Supplemental            ( ) Substitute            ( ) PCT

My residence, post office address and citizenship are as stated below next to my name.

(check one)    ☐ which is attached hereto, or  
                    ☐ which was filed on , as Application Serial No. and with amendments through  
                                                (if applicable), or  
                    ☒ in International Application No. PCT US99/18674, filed August 17, 1999, with  
                                                amendments as provided in the Preliminary Amendment filed on February 20, 2001.

I acknowledge the duty to disclose all information known by me to be material to the patentability of the claims of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

PRIOR FOREIGN APPLICATIONS (ENTER BELOW IF APPLICABLE)			PRIORITY CLAIMED (MARK APPROPRIATE BOX BELOW)	
APP. NUMBER	COUNTRY	DAY/MONTH/YEAR FILED	YES	NO
PCT/US99/18674	PCT	17 August 1999	X	

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Atlanta, Georgia 30303-1811

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Full name of first inventor: Jay A. Berzofsky

Inventor's signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: 5908 Bradley Boulevard, Bethesda, MD 20814-1107

Post Office Address: 5908 Bradley Boulevard, Bethesda, MD 20814-1107

Citizenship: United States

Full name of second inventor: Stephen M. Feinstone

Inventor's signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: 3021 Cathedral Avenue, Washington, D.C. 20008

Post Office Address: 3021 Cathedral Avenue, Washington, D.C. 20008

Citizenship: United States

Full name of third inventor: Marian E. Major

Inventor's signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: 6608 Potomac Avenue, Apt. B2, Alexandria VA 22307

Post Office Address: 6608 Potomac Avenue, Apt. B2, Alexandria, VA 22307

Citizenship: United Kingdom

Full name of fourth inventor: Pablo Sarobe

Inventor's signature:  Date: October 15<sup>th</sup> 2001

Residence: C/San Fermin 59 2D, 31003 Pamplona, Spain

Post Office Address: C/San Fermin 59 2D, 31003 Pamplona, Spain

Citizenship: Spain



I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

APPLICATION NUMBER	FILING DATE
60/097,446	21 August 1998

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information known by me to be material to the patentability of the claims of this application as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

APPLICATION SERIAL NO.	FILING DATE	STATUS (MARK APPROPRIATE COLUMN BELOW)		
		PATENTED	PENDING	ABANDONED

I hereby appoint the following attorneys to prosecute this application and to transact all business in the U.S. Patent and Trademark Office connected therewith:

James C. Haight, Reg. No. 25,588, Robert Benson, 33,612, Jack Spiegel, 34,477, Susan S. Rucker, 35,762, David R. Sadowski, 32,808, Steve Ferguson, 38,448; John Peter Kim, 38,514, Stephen L. Finley, 36,357, Norbert Pontzer, 40,777, Richard U. Rodriguez, 45,980, and Marlene Shinn, 46,005.

Address all telephone calls to Mary L. Miller at telephone no. (404) 688-0770.

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Mary L. Miller, Ph.D.  
NEEDLE & ROSENBERG, P.C.  
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Atlanta, Georgia 30303-1811

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Full name of first inventor: Jay A. Berzofsky

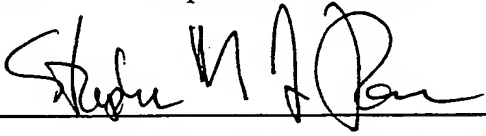
Inventor's signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: 5908 Bradley Boulevard, Bethesda, MD 20814-1107

Post Office Address: 5908 Bradley Boulevard, Bethesda, MD 20814-1107

Citizenship: United States

Full name of second inventor: Stephen M. Feinstone

Inventor's signature:  \_\_\_\_\_ Date: 10-12-01

Residence: 3021 Cathedral Avenue, Washington, D.C. 20008

Post Office Address: 3021 Cathedral Avenue, Washington, D.C. 20008

Citizenship: United States

Full name of third inventor: Marian E. Major

Inventor's signature:  \_\_\_\_\_ Date: 10-12-01

Residence: 6608 Potomac Avenue, Apt. B2, Alexandria VA 22307

Post Office Address: 6608 Potomac Avenue, Apt. B2, Alexandria, VA 22307

Citizenship: United Kingdom

Full name of fourth inventor: Pablo Sarobe

Inventor's signature: \_\_\_\_\_ Date: \_\_\_\_\_

Residence: C/San Fermin 59 2D, 31003 Pamplona, Spain

Post Office Address: C/San Fermin 59 2D, 31003 Pamplona, Spain

Citizenship: Spain

ATTORNEY DOCKET NO. 14014.0347U2  
PATENT

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In re Application of )

BERZOFSKY *et al.* )

Serial No.: 09/763,260 )

Filed: February 20, 2001 )

FOR: "MODIFIED HCV PEPTIDE VACCINE" )

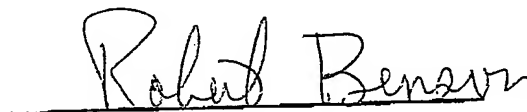
Group Art Unit: Unassigned

Examiner: Unassigned

**CONSENT OF ASSIGNEE,  
THE GOVERNMENT OF THE UNITED STATES OF AMERICA, AS REPRESENTED  
BY THE SECRETARY, DEPARTMENT OF HEALTH AND HUMAN SERVICES,  
NATIONAL INSTITUTES OF HEALTH, OFFICE OF TECHNOLOGY TRANSFER  
ACCOMPANYING PETITION FOR CORRECTION OF INVENTORSHIP IN PATENT  
APPLICATION, PURSUANT TO 37 C.F.R. §1.48(a)**

The Government of the United States of America, as Represented by the Secretary, Department of Health and Human Services, National Institutes of Health, Office of Technology Transfer, assignee of the above-captioned patent application, hereby provides its written consent for correction of inventorship in said application to delete Charles D. Pendleton and Tatsumi Arichi as co-inventors.

National Institutes of Health



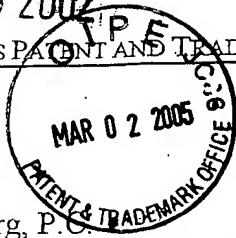
by: Robert Benson, Ph.D.

title: Supervisor, Infectious Disease and  
Medical Engineering Group



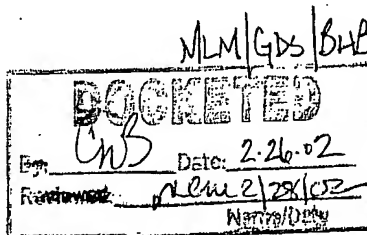
FEB 20 2002

UNITED STATES PATENT AND TRADEMARK OFFICE



COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 2023  
www.uspto.gov

Mary L. Miller  
Needle & Rosenberg, P.C.  
127 Peachtree Street, N.E., Suite 1200  
Atlanta, GA 30303



RECEIVED

FEB 25 2002

NEEDLE & ROSENBERG

In re Application of  
BERZOFKY, Jay A., et al.  
Application No.: 09/763,260  
PCT No.: PCT/US99/18674  
Int. Filing Date: 17 August 1999  
Priority Date: 21 August 1998  
Attorney's Docket No.: 14014.0347U2  
For: MODIFIED HCV PEPTIDE VACCINE

DECISION

ON PETITION UNDER

37 CFR 1.497(d)

This is a decision on "Petition For Correction of Inventorship In Patent Application, Pursuant to 37 C.F.R. §1.48(a)," filed on 19 October 2001. The petition under 37 CFR 1.48(a) is being treated as a petition under 37 CFR 1.497(d).

#### BACKGROUND

On 17 August 1999, applicants filed international application PCT/US99/18674, which claimed a priority date of 21 August 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 02 March 2000. On 17 February 2000, applicants filed a demand for international preliminary examination which elected the United States, prior to nineteen months from the priority date. The deadline for entry into the national stage in the United States was midnight 21 February 2001.

On 20 February 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration executed by five inventors.

On 21 May 2001, the Office mailed, *inter alia*, a Notification of Missing Requirements (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating, *inter alia*, that the declaration was defective because it did not properly identify the inventors.

On 19 October 2001, applicants filed "Response to Notification of Missing Requirements," including, *inter alia*, the instant petition and a declaration executed by four inventors.

### DISCUSSION

Under 37 CFR 1.41(a)(4), the inventors who submitted an application under §1.494 or §1.495 are the inventors in the international application designating the United States. The inventors in the international application include the inventors named upon filing of the international application of the international application or resulting from any changes made under Rule 92*bis* in the international stage. The record does not reflect any such requests under Rule 92*bis* during the international stage.

The inventors in the international application are Jay A. Berzofsky, Pablo Sarobe, C. David Pendleton, Stephen M. Feinstone, Tatsumi Arichi, and Marian Major. Applicants state that "the inventorship originally set forth in the application was in error in naming Mr. Pendleton and Dr. Arichi, without deceptive intent on the part of the named inventors, nor on the part of any other party or parties."

A petition under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1) and (2) have been met. (1) Applicants provided letters signed by Charles D. Pendleton and Tatsumi Arichi indicating that the error in each being named on the international application occurred without deceptive intention. (2) The processing fee set forth in §1.17(i) has been paid.

As to item (3), the written consent of assignee the United States of America is ineffective as signed by Robert Benson. First, applicants must furnish proof that the United States government is the assignee. Second, Dr. Benson's title of "Supervisor" is not one that sets him forth as an officer of the assigned and he is not presumed to have authority to sign the submission on behalf of the assignee. MPEP §324. The submission can either state that the signor is authorized to act on behalf of the assignee or "the submission may be signed by a person empowered by an organizational resolution ... to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record." MPEP §324. Evidence of Dr. Benson's authority to sign is required.

### CONCLUSION

For the above reasons, applicant's petition under 37 CFR 1.497(d) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper

Application No.: 09/763,260

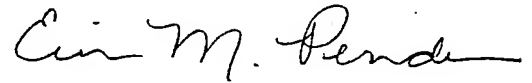
-3-

response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



Boris Milef  
PCT Legal Examiner  
PCT Legal Administration



Erin M. Pender  
Attorney Advisor  
PCT Legal Administration

Telephone: (703) 305-0455  
Facsimile: (703) 308-6459

ATTORNEY DOCKET NO. 14014.0347U2  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
BERZOFSKY <i>et al.</i>	)	
	)	Group Art Unit: Unassigned
Serial No.: 09/763,260	)	
	)	Examiner: Unassigned
Filed: February 20, 2001	)	
	)	
FOR: MODIFIED HCV PEPTIDE VACCINE	)	

RENEWED PETITION UNDER 37 C.F.R. § 1.497(d)

ATTN: Office of PCT Legal Administration  
Commissioner for Patents  
BOX PCT  
Washington, D.C. 20231

NEEDLE & ROSENBERG, P.C.  
Suite 1200, The Candler Building  
127 Peachtree Street, N.E.  
Atlanta, Georgia 30303-1811

April 17, 2002

Sir:

This is responsive to the February 20, 2002 Decision on Petition Under 37 C.F.R. §1.497(d) which was issued regarding the above-referenced patent application. Enclosed herewith are a copy of the Decision, a substitute written consent of the assignee, and a copy of the Notice of Recordation of Assignment (including the Assignment transmittal and the executed Assignment) by which the inventors have assigned their rights to the invention to The Government of the United States of America, as represented by the Secretary, Department of Health and Human Services, National Institutes of Health, Office of Technology Transfer.

REMARKS

A petition to correct inventorship regarding the above-referenced patent application was filed on October 19, 2001. On February 20, 2002, a Decision on Petition under 37 C.F.R. § 1.497(d) was issued, dismissing applicants' petition. The Decision noted that a petition under 37 C.F.R. § 1.497(d) requires (1) a statement from each person being added as an inventor and from

ATTORNEY DOCKET NO. 14014.0347U2  
PATENT

each person being deleted as an inventor that an error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in 37 C.F.R. § 1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

The Decision acknowledges that items (1) and (2) have been met. However, item (3), the written consent of the assignee is deemed ineffective. The Decision states that applicants must furnish proof that the United States Government is the assignee and show that the person signing the consent has the authority to sign the submission on behalf of the assignee. MPEP § 324.

On March 27, 2002, applicants' attorney telephoned Legal Administrator Ms. Erin Pender and confirmed that submitting the following items would correct the deficiencies in the October 19, 2001 petition and satisfy the remaining requirements under 37 C.F.R. § 1.47(d):

- (1) A copy of the Notice of Recordation of Assignment, Assignment Transmittal, and an executed Assignment regarding the pending application;
- (2) A copy of the Decision on Petition Under 37 C.F.R. § 1.47(d); and
- (3) A substitute written consent of the assignee, The Government of the United States of America, as Represented by the Secretary, Department of Health and Human Services, National Institutes of Health, Office of Technology Transfer, including a statement that the signor is authorized to act on behalf of the assignee.

Applicants herewith submit the three (3) aforementioned documents and respectfully request reconsideration and allowance of the previously submitted Petition Under 37 C.F.R. § 1.47(d).

ATTORNEY DOCKET NO. 14014.0347U2  
PATENT

No amount is believed due; however, the Commissioner is hereby authorized to charge any fees due or credit any overpayment to Deposit Account 14-0629. Should there be any questions, please contact the undersigned at 404/688-0770.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.

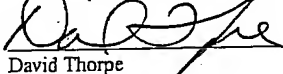
  
Mary L. Miller

Registration No. 39,303

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Atlanta, Georgia 30303-1811  
404/688-0770

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I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Invoice No. 403505525US in an envelope addressed to: ATTN: Office of PCT Legal Administration, Commissioner for Patents, BOX PCT, Washington, D.C. 20231, on the date shown below.

  
David Thorpe

4-17-02  
Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

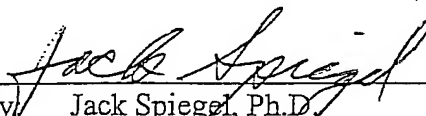
In re Application of	)	
	)	
BERZOFSKY <i>et al.</i>	)	
	)	Group Art Unit: Unassigned
Serial No. 09/763,260	)	
	)	Examiner: Unassigned
Filed: February 20, 2001	)	
	)	
FOR: "MODIFIED HCV PEPTIDE VACCINE"	)	

CONSENT OF ASSIGNEE,  
THE GOVERNMENT OF THE UNITED STATES OF AMERICA, AS REPRESENTED  
BY THE SECRETARY, DEPARTMENT OF HEALTH AND HUMAN SERVICES,  
NATIONAL INSTITUTES OF HEALTH, OFFICE OF TECHNOLOGY TRANSFER  
ACCOMPANYING PETITION FOR CORRECTION OF INVENTORSHIP IN PATENT  
APPLICATION, PURSUANT TO 37 C.F.R. §1.48(a)

The Government of the United States of America, as Represented by the Secretary, Department of Health and Human Services, National Institutes of Health, Office of Technology Transfer, is assignee of the above-referenced patent application, as evidenced by the attached copy of an Assignment from JAY A. BERZOFSKY, PABLO SAROBE, C. DAVID PENDLETON, STEPHEN M. FEINSTONE AND MARIAN E. MAJOR to the Government of the United States of America, as represented by the Secretary, Department of Health and Human Services, Office of Technology Transfer, which Assignment has been recorded with the U.S. Patent and Trademark Office at Reel/Frame 011933/0515 on June 28, 2001.

As a representative authorized to act on behalf of the assignee, I hereby provide consent for correction of inventorship in the above-referenced application to delete Charles D. Pendleton and Tatsumi Arichi as co-inventors. I further certify that I am authorized to sign this document on behalf of the assignee.

National Institutes of Health

  
By: Jack Spiegel, Ph.D.

Title: Director, Division of Technology Development  
and Transfer

MAY 17 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

 COMMISSIONER FOR PATENT  
 UNITED STATES PATENT AND TRADEMARK OFFICE  
 WASHINGTON, D.C. 2023  
 www.uspto.gov

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MAY 20 2002

Mary L. Miller  
 Needle & Rosenberg, P.C.  
 127 Peachtree Street, N.E., Suite 1200  
 Atlanta, GA 30303

NEEDLE &amp; ROSENBERG

In re Application of  
 BERZOFKY, Jay A., et al.  
 Application No.: 09/763, 260  
 PCT No.: PCT/US99/18674  
 Int. Filing Date: 17 August 1999  
 Priority Date: 21 August 1998  
 Attorney's Docket No.: 14014.0347U2  
 For: MODIFIED HCV PEPTIDE VACCINE

MLM/BSS/BHB/jmh  
 104 05/21/02 DECISION  
 new 5/24/02 REQUEST UNDER  
 37 CFR 1.497(d)

This is a decision on "Renewed Petition Under 37 C.F.R. §1.497(d)," filed 17 April 2002.

### BACKGROUND

On 17 August 1999, applicants filed international application PCT/US99/18674, which claimed a priority date of 21 August 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 02 March 2000. On 17 February 2000, applicants filed a demand for international preliminary examination which elected the United States, prior to nineteen months from the priority date. The deadline for entry into the national stage in the United States was midnight 21 February 2001.

On 20 February 2001, applicants filed a submission for entry into the national stage in the United States, which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration executed by five inventors.

On 21 May 2001, the Office mailed, *inter alia*, a Notification of Missing Requirements (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating, *inter alia*, that the declaration was defective because it did not properly identify the inventors.

On 19 October 2001, applicants filed "Response to Notification of Missing Requirements," including, *inter alia*, the request and a declaration executed by four inventors.

On 20 February 2002, the Office mailed Decision On Petition Under 37 CFR 1.497(d), refusing applicants' request for failure to provide written consent of the assignee.

On 17 April 2002, applicants submitted "Renewed Petition Under 37 C.F.R. §1.497(d)," accompanied by, *inter alia*, copies of assignments and a new consent of the assignee.

AND

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Application No.: 09/763,260

-2-

### DISCUSSION

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

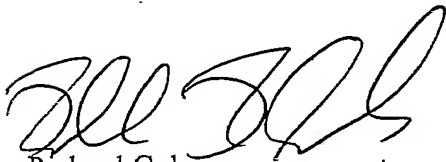
Items (1) and (2) were previously met.

Item (3) has now been met. Applicants have provided copies of the assignments and a new written consent from the assignee, the United States government. Jack Spiegel signed on behalf of the government and indicated that he has the authority to do so.

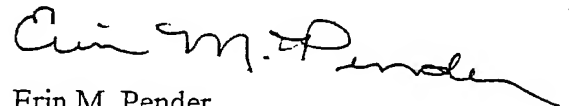
### CONCLUSION

For the above reasons, applicants' request under 37 CFR 1.497(d) is GRANTED.

The application has an international filing date of 17 August 1999 under 35 U.S.C. §363 and a date of 19 October 2001 under 35 U.S.C. §371. This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing.



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PCT Legal Examiner  
PCT Legal Administration



Erin M. Pender  
Attorney Advisor  
PCT Legal Administration

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